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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/785,082

02/25/2004

Jessica E. Barzilai

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EXAMINER

SIEFKE, SAMUEL P

ART UNIT

PAPER NUMBER

1772

MAIL DATE

DELIVERY MODE

12/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/785,082	BARZILAI ET AL.	
	Examiner	Art Unit	
	SAM P. SIEFKE	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-51, 53-56 and 58-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 49-51, 53-56 and 58-70 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 49-51, 53-56 and 58-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Earley et al. (USPN 5,455,008).

Earley teaches a system for manipulating and thermal cycling a sample well tray, comprising: a thermal cycling device (fig. 1, ref. 14) having sample blocks (14, fig. 5) for receiving the sample well tray (fig. 7, ref. 34), the sample block comprising a plurality of openings (fig. 5, ref. 31) for receiving sample wells of the sample well tray; and a sample well tray handling apparatus comprising: a sample well tray holder (fig. 2, ref. 7) configured to receive the sample well tray therein; a rotational actuator configured to rotate the sample well tray holder about a rotational axis (col. 3, lines 1-col. 4, line 2); and an extension arm extending from the rotational actuator and being connected to the sample well tray holder (col. 3, lines 1-col. 4, line 2), wherein the sample well tray handling apparatus is configured to move the sample well tray from a first location distal to the sample block to a second location proximal to the sample block and then later remove the sample well tray from the second location to the first location (col. 3, lines 1-col. 4, line 2). Earley states the microtiter plate is filled with a sample then placed on a heater 14 for five minutes at 65 degrees C to complete the denaturation step. The microtiter plate is then removed and placed on the workstation 16 where it is held at room temperature for five minutes to complete the annealing step. Next reagents are added to the microtiter plate and the plate is placed back onto the heating block 14 to begin the extension step at 65 degrees C.

Earley does not specifically teach employing only one heater block.

Earley employs multiple heating blocks 14 in order to process large amounts of samples but states that each heating block performs the sample heating step as the next. Therefore it would have been obvious to one having an ordinary skill in the art at the time of the invention to modify Earley to reduce the number of heater blocks to one in order to process one microtiter plate at a time. This omission of multiple heaters with the consequent loss of its function is well known in the art (In re Kuhle, 188 U.S.P.Q. 7) in order to reduce costs and provide a simpler device.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 49-51, 53-56 and 58-70 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6,719,949 of U.S. Patent No. 1-22. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are a broader version of the 6,719,449 Patent. The prior art claims include all the limitations found in the presently pending claims. Thus, the presently pending claims cover all the subject matter of the prior art 6,719,449 Patent.

Response to Arguments

Applicant's arguments filed 12/3/10 have been fully considered but they are not persuasive. Applicant argues, "The current Office Action asserts that the heating blocks 14 of Easley axe equivalent to the only one sample block of claim 49. However, contrary to assertions made in the current Office Action, Applicants have shown that Easley clearly discloses a system that requires several heating blocks 14. Accordingly,

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Applicants request that the rejection of claim 49 be withdrawn.” The plurality of heating blocks are employed to process a plurality of plates at the same time in a assembly line fashion. One of Easley's heating blocks can perform all the functions of the steps that are performed through the steps Easley performs. Easley states the heating blocks 14 function merely as work stations and do not produce heat. This step is an equivalent as to taking the sample tray out of the heating block and placing it on an adjacent workspace. With one heating block the following steps occur: the sample tray is placed in the first heating block for five minutes at 65 degrees C to complete the denaturation step. The microtiter plate is then removed and placed on the adjacent work space where it is held at room temperature for five minutes to complete the annealing step. Next reagents are added to the microtiter plate and the plate is placed back into the first heating block 14 to begin the extension step at 65 degrees C. All this occurs with only one heating block.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAM P. SIEFKE whose telephone number is (571)272-1262. The examiner can normally be reached on Monday, Wednesday, Thursday and Friday 8am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, InSuk Bullock can be reached on 571-272-5954. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAM P SIEFKE/
Primary Examiner, Art Unit 1772

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